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1. (Once Amended) A method for displaying on a viewer information processing system with an interface to a display, a set of multimedia segments to form a multimedia presentation, the method comprising the steps of:

receiving a play-list from a program provider, wherein the play-list is a list of instructions for the rendering of the multimedia segments into a multimedia presentation;

receiving from the program provider the multimedia segments required by the play-list; and

receiving the multimedia presentation on the display by rendering the multimedia segments as directed by the play-list.

10. (Once Amended) The method for displaying according to claim 1, wherein the step of receiving a play-list from the program provider includes receiving a play-list based on the demographics of the viewers of the multimedia presentation.

11. (Once Amended) A method for distributing program content from a program provider over a telecommunications infrastructure to a plurality of clients capable of receiving program content broken into a plurality of multimedia segments forming a multimedia presentation, the method on a program provider comprising the steps of:

breaking program content into a plurality of multimedia segments;

transmitting at least one play-list to at least one client, wherein the play-list is a list of instructions for the rendering of the multimedia segments into a multimedia presentation; and

transmitting the multimedia segments required by said play-lists that form the multimedia presentation.

12. (Once Amended) The method of claim 11 [10], where the program provider transmits at least one multimedia segment to at least one client prior to the multimedia presentation by the client.

18. (Once Amended) A computer readable medium comprising programming instructions for displaying on a viewer information processing system with an interface to a display, a set of multimedia segments to form a multimedia presentation, the programming instructions comprising

receiving a play-list from a program provider, wherein the play-list is a list of instructions for the rendering of the multimedia segments into a multimedia presentation;

receiving from the program provider the multimedia segments required by the play-list; and

displaying the multimedia presentation on the display by rendering the multimedia segments as directed by the playlist.

19. (Once Amended) The computer readable medium [method] of claim 18 [15] wherein said programming instruction includes receiving at least one multimedia segment prior to the presentation being displayed, and storing at least one multimedia segment.

22. (Once Amended) The computer readable medium according to claim 18 [19], wherein the programming instruction of receiving multimedia segments includes receiving at least one multimedia segment over a telecommunications network.

24. (Once Amended) The computer readable medium according to claim 18 [19], wherein the programming instruction of displaying includes displaying the multimedia segments from the information processing system on a television set.

25. (Once Amended) The computer readable medium according to claim 18 [19], wherein the programming instruction of receiving multimedia segments includes receiving at least one multimedia segment of an advertisement.

26. (Once Amended) The computer readable medium according to claim 18 [19], wherein the programming instruction of receiving multimedia segments includes receiving at least one multimedia segment of program content.

27. (Once Amended) The computer readable medium according to claim 18 [15], wherein the programming instruction of receiving a play-list from the program provider includes receiving a play-list based on the demographics of the viewers of the multimedia presentation.

28. (Once Amended) A viewer information processing system with an interface to a display, for receiving a set of multimedia segments to form a multimedia presentation, the viewer information system comprising

a receiver for receiving a play-list from a program provider wherein the play-list is a list of instructions for the rendering of the multimedia segments into a multimedia presentation;

a receiver for receiving the multimedia segments from the program provider;

a means for rendering the multimedia segments into a multimedia presentation as directed by the play-list; and

an interface to a display for displaying said multimedia presentation.

29. (Once Amended) The viewer information processing system [apparatus] of claim 28, [24] further comprising [wherein said apparatus includes] an interface to storage for storing at least one multimedia segment.

REMARKS

Applicants have studied the Office Action dated October 23, 2002. It is submitted that the application is in condition for allowance. Claims 1, 10-12, 18-19, 22, and 24-29 have been amended. Claims 1-33 are pending in view of the above amendments. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks are respectfully requested. In the Office Action, the Examiner:

- rejected claims 12, 19, 22, 24-27 and 29 under 35 U.S.C. § 112, second paragraph, as being indefinite and for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention
- rejected claims 1-5, 8-16, 18-22, 25-32 under 35 U.S.C. § 102(e) as being anticipated by Seidman
- rejected claims 6, 7, 17, 23, 24 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Seidman

Rejection under 35 U.S.C. §112

As noted above, the Examiner rejected claims 12, 19, 22, 24-27 and 29 under 35 U.S.C. § 112, second paragraph, as being indefinite and for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In the Office Action, the Examiner described suggested changes that may be made to claims 12, 19, 22, 24-27 and 29 in order to overcome this rejection. The Applicants wish to thank the Examiner for his suggestions. Claims 12, 19, 22, 24-27 and 29 have been amended by the Applicants in accordance with the Examiner's suggestions. Therefore, the Examiner's rejection under 35 U.S.C. § 112, second paragraph, has been overcome and the rejection should be withdrawn.

Rejection under 35 U.S.C. §102(e) over Seidman

As noted above, the Examiner rejected claims 1-5, 8-16, 18-22, 25-32 under 35

U.S.C. § 102(e) as being anticipated by Seidman. Claims 1, 10-12, 18-19, 22, and 25-29 have been amended in order to more particularly point out and distinctly claim the Applicants' invention. In view of the amendment above, the Applicants respectfully submit that independent claims 1, 11, 18, and 28 as amended distinguish over Seidman

The Applicants' invention is directed towards a method for displaying on a viewer information processing system with an interface to a device for rendering audio video display, a set of multimedia segments to form a multimedia presentation. The method includes receiving a play-list from a program provider, wherein the play-list is a list of instructions for rendering each of the multimedia segments received and the sequence of the multimedia segments in the play-list is directed by the program provider. The method further includes receiving multimedia segments and rendering the multimedia segments received based on the play-list.

The program provider transmits program content (e.g., television programs) and play-lists to coordinate the display of the multimedia segments received at viewers' units (e.g., a set-top box coupled to a television receiver or an information processing apparatus with a display). The program provider obtains information from, or about, its customers that is of great use in determining what content to provide to its viewers. The program provider transmits play-lists that are recognized at the viewer's unit and used to select multimedia segments for display to the viewer. Thus, Applicants' invention represents a new business model for tailoring and delivering multimedia segments in a network such as a cable network or a public data network such as the Internet. The program provider tailors and charges for multimedia segments tailored to a viewer.

Seidman is directed towards a system for two-way digital multimedia broadcast services, enabling a variety of interactive and other applications. The applications include: navigation from one video program to another by selection of objects in the current video; creation and transmission of records of user viewing selection histories; iterative video-based data search and retrieval; dynamic customization of coordination

between video content of the broadcast stream and data embedded therein; and the dynamic creation of "personalized" programs by the user without, through the broadcast and selection of overlapping program segments which are themselves customized for a particular user or group of users.

Seidman discloses a method of customizing video programs received by each subscriber or by a group of subscribers. A set of program segments of the program are transmitted from the head end to the group of subscribers, where the set is selected by the head end server in accordance with profile information on group of subscribers. Then, each of the subscribers selects a respective ordered subset of the set of program segments. A subset can be ordered by the subscriber without sending any data to the head end server.

Seidman further discloses a method of acquiring subscriber selection history information on a number of subscribers is provided. Selected video programs are transmitted from the head end to the subscribers in response to requests for the selected video programs from the subscribers. Each of the subscribers selects objects in a received video programs, where each object is an image in one of video programs, is not a part of any embedded data added to the programs, and corresponds to a file containing information on a subject which corresponds to the appearance of each respective object. Finally, a selection database history of the object selections is maintained. This selection database history can then be used to dynamically adjust the correspondence of the objects to the files, where each subscriber receives customized information in response to selecting an object.

In contrast, in preferred embodiments of the Applicants' invention, the play-lists are generated by the program provider and transmitted to the set-top boxes of the user. In Seidman, the user selects objects (i.e., a play-list) for a personalized view. This aspect of Applicants' invention is advantageous as it allows the program provider (not the user) to tailor the media received and viewed by the user, in accordance with demographic and other data collected with regards to the viewer. Further, this aspect

of Applicants' invention is advantageous as it allows for targeted advertising of viewers in accordance with demographic and other data collected with regards to viewers. Note that independent claim 1 has been amended for clarity to include the following limitations:

> *receiving a play-list from a program provider, wherein the play-list is a list of instructions for the rendering of the multimedia segments into a multimedia presentation;*
>
> *receiving from the program provider the multimedia segments required by the play-list (Emphasis added)*

The foregoing limitations of claim are directed towards the reception of a play-list from the program provider, wherein the play-list describes how the multiple streams of data (i.e., the multimedia segments) shall be combined to produce a multimedia presentation for display to the user/viewer. Unlike Seidman, the user makes no selections and does not specify how the presentation is generated. According to Applicants' invention, the program provider determines the manner in which the presentation is generated, in accordance with demographic and other data collected with regards to the user.

Therefore, amended independent claim 1 distinguishes over the Seidman reference. The Seidman reference does not teach, anticipate, or suggest all of the recited elements of independent claim 1 - namely the reception of a play-list generated by the program provider in accordance with data collected with regards to the user. Therefore, the Examiner's rejection should be withdrawn and it is respectfully submitted that Independent claim 1 is in a condition for allowance.

Amended independent claims 11, 18 and 28 include all of the limitations of independent claim 1. Thus, for the reasons stated above for independent claim 1, the Seidman reference does not teach, anticipate, or suggest all of the recited elements of independent claims 11, 18 and 28 - namely the reception of a play-list generated by the

program provider in accordance with data collected with regards to the user. Therefore, the Examiner's rejection should be withdrawn and it is respectfully submitted that independent claims 11, 18 and 28 are in a condition for allowance.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Seidman.[1] Because the elements in independent claims 1, 11, 18, and 28 "a play-list from a program provider" is not taught or disclosed by Siedman. Accordingly, the present invention distinguishes over Kawamura for at least this reason. The Applicants respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome.

As discussed above, independent claims 1, 11, 18 and 28 distinguish over the Seidman reference, and thus, dependant claims 2-10, 12-17, 19-27 and 29-33, which depend from independent claims 1, 11, 18 and 28, respectively, also distinguish over the Seidman reference. Therefore, the Examiner's rejection should be withdrawn and it is respectfully submitted that dependant claims 2-10, 12-17, 19-27 and 29-33 are in a condition for allowance.

Rejection under 35 U.S.C. §103(a) over Seidman

As noted above, the Examiner rejected claims 6, 7, 17, 23, 24 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Seidman. Independent claims 1, 11, 18 and 28, from which claims 6, 7, 17, 23, 24 and 33 depend, respectively, have been amended in order to more particularly point out and distinctly claim the Applicants'

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[1] See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

invention. In view of the amendment above, the Applicants respectfully submit that independent claims 1, 11, 18, and 28 distinguish over Seidman taken alone or in view of the Examiner's Official Notice.

In addition to the Seidman reference, the Examiner asserts Official Notice that it is well-known in the art that: 1) multimedia content can be received over the Internet and 2) television sets can be used as displays. The Examiner's Official Notice does not teach, anticipate, or suggest all of the recited elements of independent claims 1, 11, 18 and 28 - namely the reception of a play-list generated by the program provider in accordance with data collected with regards to the user.

Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such as the proposed modification, is not proper and the *prima facie* case of obviousness cannot be properly made. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Here the solution taught by Seidman does not allow the program provider to control the play list through "receiving a play-list from the program provider". The Seidman reference taken alone or in view of the Examiner's Official Notice as suggested by the Examiner destroys the intent and purpose of the present invention of control of the play-list including commercials and advertisements by the program provider. Accordingly, the present invention is distinguishable over Seidman taken alone and/or in view of the Official Notice for this reason as well.

Continuing further, when there is no suggestion or teaching in the prior art for having the program provider provide the play-list including which commercials previously delivered to be rendered the suggestion can not come from the Applicant's own specification. As the Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re

Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Seidman does not even suggest, teach or mention this type of control over advertisement by the program provider.

Further, as discussed above, independent claims 1, 11, 18 and 28 distinguish over the Seidman reference, and thus, dependant claims 6, 7, 17, 23, 24 and 33, which depend from independent claims 1, 11, 18 and 28, respectively, also distinguish over the Seidman reference. Therefore, neither the Seidman reference, nor the Examiner's Official Notice, nor a combination of the two, teaches, anticipates, or suggests all of the recited elements of independent claims 1, 11, 18 and 28 Therefore, the Examiner's rejection should be withdrawn and it is respectfully submitted that dependant claims 6, 7, 17, 23, 24 and 33 are in a condition for allowance.

Additionally, the Examiner is reminded the Seidman reference is commonly assigned with the present invention to International Business Machines Corporation of Armonk New York. The present invention has an assignment recorded at Reel 10295/ Frame 0841 to the Assignee, International Business Machines Corporation. Under MPEP 715.01(b):

> Where, however, [...], in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e)/103 using the reference patent, a showing that the invention was commonly owned at the time the later invention was made would preclude such a rejection or be sufficient to overcome such a rejection. >See MPEP § 706.02(l) and §706.02(l)(1).

Accordingly, the Examiner is reminded the mere filing of a continuation application or RCE will remove this commonly owned reference under a 35 U.S.C. 102(e)/103 rejection.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted.

Dated: January 23, 2003 By: _____

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